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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/147,129	10/14/1998	YASUHIRO SUZUKI	9829-0001-OX	1274

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EXAMINER

MCDOWELL, SUZANNE E

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/147,129

Applicant(s)

SUZUKI ET AL.

Examiner

Suzanne E. McDowell

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 13-20, 23, 24, 26, 32, 33, 35-40, 49-53, and 58 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 12, 21, 22, 25, 27-29, 34, 41-48 and 54-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of species a in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the species belong to the same Markush group and are therefore not restrictable. This is not found persuasive because the prior art teaches specific chemical constituents for the moldings and coatings of recyclable products, which are then related to the process of recycling. The different resins do not appear to be interchangeable.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9-11, 30 and 31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

### ***Claim Objections***

3. Claim 24 is objected to because of the following informalities: it is believed by the examiner that claim 24 should be dependent upon claim 23, and not claim 22. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5-7, 13, 16, and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 54-047771. JP 54-047771 discloses a method of coating the surface of a thermoplastic resin molding with a resin that is compatible with the thermoplastic utilized for the molding, where both resins are preferably the same. Using the same resin for the molding and the coating would result in the claimed affinity,

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nature, and compatibility. JP 54-047771 further discloses that the resins may be polyolefin, acrylic, vinyl, polyesters, etc.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54-047771. JP 54-047771 teaches a method of coating the surface of a thermoplastic resin molding with a resin that is compatible with the thermoplastic utilized for the molding, where both resins are preferably the same. JP 54-047771 discloses a method of coating the surface of a thermoplastic resin molding with a resin that is compatible with the thermoplastic utilized for the molding, where both resins are preferably the same does not specifically teach that the molding is coated on an outer surface or an "outer or inner surface". It is generally well known in the art that a coating is applied to the surface of a molding. It would have been obvious to a person of ordinary skill in the art at the time of the invention to further define the method taught by JP 54-047771 and coat the outer surface or an "outer or inner surface" of the molding, in order to obtain a coated surface.

8. Claims 17-20, 23, 24, 26, 32, 33, 49-53, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman (US Patent 5,569,713) in view of JP 54-047771. Lieberman teaches a basic method of recycling, as well as testing the characteristics of the recycled material, wherein the material may be a coated material such as a bumper formed with a foamed polypropylene core and a polyurethane shell (column 5, lines 50-54), or may be a resin or blend of resins (column 5, lines 10-49). Lieberman teaches collecting recycled material (10, 12, 14); particularizing the material (step 16); testing the material (18) to determine its physical properties); possibly adding additives (22) to the material, such as at least

1% by weight of a compatibilizing agent (column 3, lines 60-62); compounding the material in an extruder (38); subjecting the material to heat, pressure and shear force to liquefy and completely mix the material (column 7, lines 5-25); pelletizing the material (26); forming the pellets into test samples and testing the properties (28); depending upon the results of the tests, adding virgin material (30) and forming finished parts, or beginning again at step 22 (column 8, lines 40-54). Lieberman does not teach that the coated material is coating with a resin with the properties of the claimed affinity, nature, and compatibility. JP 54-047771 teaches a method of coating the surface of a thermoplastic resin molding with a resin that is compatible with the thermoplastic utilized for the molding, where both resins are preferably the same. Using the same resin for the molding and the coating would result in the claimed affinity, nature, and compatibility. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the material taught by JP 54-047771 to modify the method taught by Lieberman, in order to avoid having unmoldable material, such as paint, in the final pellets. (Lieberman column 7, lines 53-56).

#### ***Allowable Subject Matter***

9. Claims 4, 8, 12, 21, 22, 24, 27-29, 34, 41-48, and 54-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne E. McDowell whose telephone number is (703) 305-4018. The examiner can normally be reached on M-F 6:30-4:

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianne can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

SEM  
August 25, 2003

*Suzanne E McDowell*  
SUZANNE E. MCDOWELL  
PRIMARY EXAMINER